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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/646,483 | 08/22/2003 | John William Vogler | 71602 | 9445 |

7590 12/29/2005

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| EXAMINER |
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GOFF II, JOHN L

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| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,483

Applicant(s)

VOGLER ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 22-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/03, 12/03, 10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Species II (claims 1-9 and 11-21) in the reply filed on 12/5/05 is acknowledged. The traversal is on the ground(s) that there is no serious search burden. This is not found persuasive because the restriction properly set forth that the inventions were distinct as evidenced by their different classifications.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher (U.S. Patent 3,320,110).

Gallagher discloses a method of making a cigarette filter comprising providing an aggregation, i.e. mass of, cellulose acetate fibers, providing a cellulose acetate paper, exposing (e.g. by spraying, brushing, etc.) a side of the paper to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), and exposing and contacting the aggregation of fibers to the plasticizing solvent and paper to solvent bond, i.e. cure, the aggregation of cellulose fibers to the

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paper (Figures 1 and 2 and Column 1, lines 11-20 and Column 3, lines 35-75 and Column 4, lines 1-13 and Column 6, lines 20-40).

4. Claims 1-9 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Ruback (GB 848,429).

Ruback discloses a method of making a cigarette filter comprising providing an aggregation, i.e. mass of, cellulose acetate fibers, exposing the aggregation of fibers to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), providing a paper, exposing a side of the paper to a plasticizing solvent, wrapping the aggregation of fibers with the paper to form a filter, and solvent bonding, i.e. curing, the filter by allowing the filter to stand at room temperature to adhere the aggregation of cellulose fibers to the paper (Page 1, lines 37-43 and Page 2, lines 48-78 and the Example).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-9 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobb (U.S. Patent 3,025,861) in view of Gallagher and optionally Cobb et al. (U.S. Patent 3,106,501).

Cobb discloses a method of making a cigarette filter comprising providing an aggregation, i.e. mass of, cellulose acetate fibers, exposing the aggregation of fibers to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), providing an acetate paper, exposing a side of the paper to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), and wrapping the aggregation of fibers with the paper to solvent bond, i.e. cure, the aggregation of cellulose fibers to the paper (Figures 1 and 2 and Column 1, lines 10-16 and Column 2, lines 8-10 and 43-67 and Column 3, lines 65-75 and Column 4, lines 67-75 and Column 5, lines 1-7 and 36-39). Cobb is silent as to the acetate paper comprising cellulose acetate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the acetate paper in Cobb those well known and conventional in the art such as those formed from cellulose acetate as shown for example by Gallagher as only the expected results would be achieved. Cobb is silent as to an application technique for the plasticizing solvent to the aggregation of fibers and/or paper. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the plasticizing solvent as taught by Cobb using any well known and conventional technique such as by spraying the aggregation of fibers either before or after condensing as optionally shown for example by Cobb et al. or

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spraying and/or brushing onto the paper as shown for example by Gallagher as only the expected results would be achieved.

Gallagher is described above in full detail. Cobb et al. disclose a method of making a cigarette filter comprising providing an aggregation, i.e. mass of, cellulose acetate fibers, exposing (e.g. by spraying) the aggregation of fibers either before or after condensing to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.) to solvent bond, i.e. cure, the aggregation of fibers, providing a paper, and wrapping the aggregation of fibers with the paper (Figures 2, 5, and 6 and Column 4, lines 29-57 and Column 5, lines 10-23).

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Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John L. Goff



JEFF H. AFTERGUT
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